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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,695	05/03/2001	Rigby Jacobs Heusinkveld	10007179-1	5737

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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/848,695	HEUSINKVELD, RIGBY JACOBS	
	Examiner	Art Unit	
	Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 27 May 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-25 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/2/05 has been entered.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirst et al. (5930553) in view of Junger et al. (2004/0172260).

For claims 1,2,5-10,12,17-19,21,22, Hirst discloses an image forming consumable for printers. The consumable item is 18 and the consumable item has an interface to allow communication with the device (the printer/computer the consumable is used in), see column 2, lines 37-39 and lines 43-47. The memory is 19 (means for storing) and is disclosed as storing the kind of information as claimed. The memory is fully capable of storing any kind of data. The consumable item 18 is disclosed as having computer instructions (means for obtaining) that obtain various types of data that is to be stored on the memory 19. Warranty information such as installation date, and use data such as the number of prints, can be obtained and stored in the memory 19.

See column 3, lines 16-33. Hirst discloses that an Internet connection can be used to transfer usage and statistical data from the memory 19, see column 6, lines 16-20. Not disclosed is the limitation of computer executable instructions that are configured to request additional warranty information from the user.

Hirst discloses that the consumable can store warranty data and usage data in memory 19. In column 6, lines 16-20 Hirst discloses that with respect to the software of the invention, "*Other modifications include providing an Internet or BBS link to provide an additional or bidirectional communication with an image forming device to transfer code patches, usage and statistical information as well as informing the user of new features*".

Junger discloses an automated warranty system where the user can use the Internet to obtain information about the return of a product or *can use the Internet to initiate a product return*. Junger discloses that by allowing a consumer to use the Internet to initiate a product return, this saves the retailer or manufacturer from having to become involved in the return process and eliminates the need for call centers, provides more efficient handling of the shipping of the product, and overall provides a simplified process of initiating and tracking a product return. The consumer uses a web site that requests some information such as name, address from the consumer initiating a product return. The automated system then uses the user entered data to check if the product qualifies for a return under the warranty. If the product is qualified for a return under the warranty a return authorization is provided to the consumer and return instructions are also given to the consumer on how to go about returning the product.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Hirst with computer instructions that would link the consumer to a web site where a product return can be initiated as disclosed by Junger (means for interacting and means for completing). Hirst discloses that some of the software stored in the memory 19 of consumable 18 can provide an Internet link for the purposes of data communication for software patches and transfer of usage and statistical data. One of ordinary skill in the art would have found it obvious to provide Hirst with the ability to allow the consumer to initiate a product return in the manner disclosed by Junger so that the advantages of the invention of Junger can be realized (i.e. eliminates the need for call centers, provides more efficient handling of the shipping of the product, and overall provides a simplified process of initiating and tracking a product return).

For claims 3,11,20, not disclosed is the limitation of computer instructions configured to print the completed warranty information and printing the information as claimed in claim 11. It would have been obvious to one of ordinary skill in the art at the time the invention was made to print the completed warranty information for the consumer so that the consumer has a hard copy record of the information relating to the product return and has a copy of the instructions that are to be followed for returning the product to the manufacturer. This is similar to the act of providing the consumer a receipt for a returned product and would have been obvious to one of ordinary skill in the art.

For claim 4, Hirst discloses a processor. See column 4, lines 39-44 where it is disclosed that the consumable 18 has a sensor that detects toner level and that can send out a low toner signal when such a condition is detected. This method of sensing data and sending out a signal inherently requires a processor. You need a processor to perform these steps. There must also be a processor to allow for the storage of data and for carrying out the computer instructions stored in the consumable memory.

For claims 13,23, not disclosed is the running of a diagnostic test as claimed. If the consumer notices that the consumable does not appear to be working properly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to perform a diagnostic test to determine if the consumable is defective or not. This could simply be the act of attempting to print a test page to see if the printer is working ok or can be the act of running a software diagnostic routine to check the printer and consumable as is well known in the art.

For claims 14,24, not specifically disclosed is the data comparison claimed. When a consumer is using the Internet to initiate a product return, Junger discloses that the data about the product is used to verify if the return is to be accepted or not. The product data is compared to warranty data to be able to make a determination of whether or not the product is to be accepted as a valid return. Because Hirst discloses that the Internet connection can be used to transfer usage data and statistical data, it would have been obvious to one of ordinary skill in the art to compare the diagnostic test data to warranty data to determine if the consumable is defective or not. Part of the determination of whether or not a product is defective is to assess what is wrong with

the product (i.e. reason for return) and using diagnostic test data would have been very obvious to one of ordinary skill in the art at the time the invention was made because this is the kind of data that would tell you what was wrong with the consumable.

For claims 15,25, when the user is using the Internet to conduct a product return, the resulting invention results in the use data, user provided information, and warranty information being stored in an external memory as claimed because in Junger the data is being saved so that one can track the return. The data that is communicated over the Internet is saved in memory as claimed.

For claim 16, the replacement consumable is interpreted to be the use of another consumable in the system of Hirst. A second consumable would have the same software for Internet product return initiation as the first one does.

4. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL
PRIMARY EXAMINER